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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/751,173	01/02/2004	Carl Marhaver	60347.0001US01	3354

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EXAMINER	
WOODS, TERESA S	
ART UNIT	PAPER NUMBER
4114	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/751,173	MARHAVER, CARL	
	Examiner	Art Unit	
	TERESA WOODS	4114	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *02 January 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-21* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) ___ is/are allowed.

6)☒ Claim(s) *1-21* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *02 January 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Status of Claims

1. This action is in reply to the application filed on 01/02/2004.

2. Claim 1-21 are currently pending and have been examined.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1, 7, 8, and 14 are rejected under 35 U.S.C. 102(e) as being anticipated by McNerney (US 2003/0088441 A1).

Claim 1:

McNerney, as shown, discloses the following limitations:

- *compiling a central database containing medical information about a patient, in which the database is accessible by an examining physician and a dispensing pharmacy;* (see at least Fig. 4, ¶0032; ¶0029)
- *evaluating the patient's present condition by a qualified person in a treatment facility, with a person in the treatment facility using the information in the database to arrive at a diagnosis;* (see at least ¶0008)
- *alerting the dispensing pharmacy by the physician providing the diagnosis, of any medications prescribed;* (see at least Fig 4, (¶0032))
- *accessing the database by the pharmacy prior to the dispensing of prescription drugs;* (see at least Fig 4, (¶0032))
- *updating the database by the pharmacy of the medications actually dispensed to the patient.* (see at least Fig 4, (¶0033 and 0034))

Claim 7:

McNerney as shown below discloses the following limitations:

- *in which the dispensing pharmacy reviews the patient database regarding negative drug interaction of the medication being currently dispensed, prior to the actual dispensing of the medication.* (see at least ¶0045)

Claim 8:

McNerney as shown below, discloses the following limitations:

- *compiling a central database containing medical information about a patient, in which the database is accessible by an examining physician and a dispensing pharmacy;* (see at least Fig. 4, ¶0032; ¶0029)
- *evaluating the patient's present condition by a qualified person in a treatment facility, with a person in the treatment facility using the information in the database to arrive at a diagnosis;* (see at least ¶0008)
- *providing the evaluation information to a physician, who is able to access the information in the database with the evaluation information to arrive at a diagnosis;* (see at least ¶0010),
- *updating the database for the patient;* (see at least ¶0029),

- *alerting the dispensing pharmacy by the persons responsible for issuing the diagnosis, of any medications prescribed;* (see at least Fig 4, (¶0032))
- *accessing the database by the pharmacy prior to the dispensing of prescription drugs;* (see at least Fig 4, (¶0032))
- *updating the database by the pharmacy of the medications actually dispensed to the patient* (see at least Fig 4, (¶0033 and 0034))

Claim 14:

McNerney, as shown below, discloses the following limitations:

- *the dispensing pharmacy reviews the patient database regarding negative drug interaction of the medication being currently dispensed, prior to the actual dispensing of the medication* (see at least ¶0045).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over McNerney.

Claim 2:

McNerney, as shown, discloses *the treatment facility updates the medical history of the patient following diagnosis…of any medications prescribed (Fig. 4, items 34 & 34a, (¶0044-0045)).* McNerney does not specifically disclose ...*prior to alerting the dispensing pharmacy by the physician providing the diagnosis.* However, the Examiner takes **Official Notice** that it is old and well-known in the medical arts to supply a prescription before dispensing medications. It would have been obvious to one of ordinary skill in the art at the time of the invention to update the patient's medical history database with prescription orders prior to dispending said medications at the pharmacy because this would prevent unauthorized use of controlled substances.

8. Claims 3, 4, 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over McNerney (US PGP 2003/0088441 A1) in view of Ross (US 5,823,948 A).

Claim 3:

McNerney discloses the limitations as shown in the rejections above. McNerney does not disclose the following limitation; however Ross, as shown below does:

- *the evaluation of the patient is done initially by a nurse or other similarly trained professional, with the diagnosis and prescribing of medication performed by a physician* (see at least column 6, lines 54-60).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the physician and pharmacist database of McNerney with Ross' doctor and nurse exclusion technique because it is better utilize the skills and time constraints of properly qualified personnel.

Claim 4:

McNerney discloses the limitations as shown in the rejections above. McNerney does not disclose the following limitation; however Ross, as shown below does:

- *the physician is off-site from the location where the patient is being evaluated, and where the physician is contacted by the treatment facility through electronic means* (see at least column 12, lines 2-8).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the physician and pharmacist database of McNerney with Ross' off-site doctor communication technique because it is a fast and

efficient way to contact medical professionals in a widely dispersed geographic area.

Claim 9:

McNerney discloses the limitations as shown in the rejections above. McNerney does not disclose the following limitation; however Ross, as shown below does:

- *in which the treatment facility has specialty physicians within the treatment facility evaluators* (see at least column 11, lines 28-33).
- *with the contact including at least one of the following: audio contact; text contact through the Internet or visual images capable of being sent through electronic means. (see at least column 47, lines 30-41).*

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the physician and pharmacist database of McNerney with Ross.

Claim 10:

McNerney discloses the limitations as shown in the rejections above. McNerney does not disclose the following limitation; however Ross, as shown below does:

- *the evaluation of the patient is done initially by a nurse or other similarly trained professional, who determines whether or not*

contact with the physician requires remote electronic contact or physical contact. (see at least column 9, lines 28-35).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the physician and pharmacist database of McNerney with Ross' option to share patient's evaluation with a physician electronically.

Claim 11:

McNerney discloses the limitations as shown in the rejections above. McNerney does not disclose the following limitation; however Ross, as shown below does:

- *A method of combining physician and pharmaceutical care with an integrated data base, as recited in claim 8, in which the physician is off-site from the location where the patient is being evaluated, and where the physician is contacted by the treatment facility through electronic means (see at least column 11, line 66 through column 12, line 8).*

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the physician and pharmacist database of McNerney with Ross' ability to evaluate patients remotely and prescribe medications electronically.

9. Claims 5, 6, 12, 15-19, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over McNerney (US PGP 2003/0088441 A1) in view of Giannini (US PGP 5,915,241 A).

Claim 5:

McNerney discloses the limitations as shown in the rejections above. McNerney does not disclose the following limitation, but Giannini discloses *in which the fee is determined for the patient following the diagnosis, and where the fee is based on the average fee for the type of diagnosis that the patient receives* (see at least the abstract). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the fee structure technique of Giannini with McNerney's updatable patient database because this would make medical cost uniform and accessible for both physicians and prescribing pharmacist.

Claim 6:

McNerney discloses the limitations as shown in the rejections above. McNerney does not disclose the following limitation, but Giannini discloses *in which the person doing the evaluation determines that the patient requires a specialty physician, and directs the patient to a specialty physician for diagnosis* (see at least the abstract). It would have been obvious to one of ordinary skill in the art at the time of the invention that McNerney's updatable patient database to include prescriptions accessible for any specialty physicians as well. This would allow medical evaluators, physicians or specialty physicians the ability to write prescriptions and view patient's pharmaceutical records to avoid any negative drug interactions.

Claim 12:

McNerney discloses the limitations as shown in the rejections above. McNerney does not disclose the following limitation, but Giannini discloses *the fee is determined for the patient following the diagnosis, and where the fee is based on the average fee for the type of diagnosis that the patient receives(see at least column 4, lines 54-61 and column 8, line 63 through column 9, line 2).* It would have been obvious to one of ordinary skill in the art at the time of the invention to integrate McNerney's updatable patient database to include a fee method of diagnosis so that it is easily accessible to determine healthcare cost.

Claim 15:

McNerney discloses the limitations as shown in the rejections above. In addition, McNerney discloses *combining physician and pharmaceutical care with an integrated database* (see at least Fig. 4, ¶0032; ¶0029). McNerney does not disclose *a uniform fee structure, in which a fee is established that is directly related to a specific type of diagnosis.* However, Giannini discloses "a fee structure is established that is directly related to a specific type of diagnosis"(see at least column 8, line 63 through column 9, line 2). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the database system of McNerney with the fee structure of Giannini because, "By switching from traditional paper-based information system to an electronic system powered by internet technology, the healthcare industry can quickly realize cost saving" (McNerney Para 0003).

Claim 16:

Giannini discloses the limitations as shown in the rejections above. Giannini does not disclose *in which a fee is established that is directly related to a specific type of diagnosis.* McNerney, however, discloses *a method of combining physician and pharmaceutical care with an integrated data base, with a uniform fee structure* (abstract). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the fee structure techniques of McNerney with Giannini's fee structure based on a patient' diagnosis be available to both physicians and prescribing pharmacist.

Claim 17:

Giannini and McNerney, as shown, discloses the following limitations:

- *in which the pharmacy* updates (McNerney, see at least Fig. 4, items 22 and 35a) *the database regarding the medications actually dispensed to the patient and the actual costs of the medications, and determines the total cost for each patient of a particular diagnosis*(Giannini, see at least column 8, line 63 through column 9)*, line5, and then averaging the cost per patient for each type* (Giannini, see at least abstract, lines 5-9).

Claim 18:

McNerney as shown discloses *a method of combining physician and pharmaceutical care with an integrated data base. Giannini*, as shown, discloses *with a uniform fee structure* (see at least Abstract lines 14-18). Giannini does not

specifically disclose *...in which the pharmacy alerts the treatment center of any new increases in medication costs are.* However, the Examiner takes **Official Notice** that it is old and well-known in the medical arts for health care insurance companies to inform patients and healthcare providers of premium increases. It would have been obvious to one of ordinary skill in the art at the time of the invention, because this would prevent unforeseen medical costs possibly not being paid.

Claim 19:

McNerney discloses *a method of combining physician and pharmaceutical care with an integrated data base* as shown in the rejections above. In addition, Giannini discloses, *in which the patients are grouped according to their diagnosis for purposes of setting fees, and quality control evaluations* (see at least Abstract lines 14-18). It would have been obvious to one of ordinary skill in the art at the time of the invention to group the patients according to the diagnosis because this would ensure a more accurate and efficient method of treatment.

Claim 21 :

McNerney, as shown below, discloses the following limitation:

- *A method of combining physician and pharmaceutical care with an integrated data base, in which the patients are grouped according to their diagnosis for purposes of setting fees, and quality control evaluations(*see at least Fig. 5, and ¶*0034).*

10. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over McNerney (US PGP 2003/0088441 A1) in view of Moukheibr (US 6,021,404 A).

Claim 13:

McNerney discloses the limitations as shown in the rejections above. McNerney does not disclose the following limitation, but Moukheibr, as shown below, discloses the following limitations:

- *the person doing the evaluation determines that the patient requires a specialty physician, and directs the patient to a specialty physician for diagnosis(see at least column 7, lines 50-59).*

It would have been obvious to one of ordinary skill in the art at the time of the invention to do a specialist referral because this would ensure a more accurate and efficient method of treatment.

11. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over McNerney(US PGP 20030088441 A1) in view of Giannini (US 005915241), and further in view of Ross (US 5,823,948 A)

Claim 20 :

The combination of McNerney/Giannini disclose the limitations as shown in the rejections above. McNerney/Giannini do not disclose the following limitation, but Ross, as shown, does:

- *the effectiveness of treatment determined for the patient group over a period of time* (see at least column 1, lines 50-57).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the data grouping system of McNerney/Giannini with the time-based evaluation of a patient's improvements because this would ensure a more accurate and efficient method of treatment.

Conclusion

Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **Teresa Woods** whose telephone number is **571.270.5509.** The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **JAMES A. REAGAN** can be reached at **571.272.6710**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://portal.uspto.gov/external/portal/pair . Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).

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Examiner, Art Unit 4114

11/19/2008

/James A. Reagan/
Supervisory Patent Examiner, Art Unit 4114